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09/855,242	05/15/2001	Ryohei Sato	14632	8991

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EXAMINER
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DANIEL JR, WILLIE J

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/855,242

Applicant(s)

SATO, RYOHEI

Examiner

Willie J. Daniel, Jr.

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to applicant's amendment filed on 21 December 2006. **Claims 10-20** are now pending in the present application and claims 1-9 are canceled. This office action is made **Final**.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tokoro (US 6,349,324)** in view of **Tsai (US 6,757,301 B1)**.

Regarding **claim 10**, Tokoro discloses a cellular telephone apparatus which has a cellular telephone set capable of originating a plurality of calls to a base station (see col. 4, lines 48-50; Fig. 1) and communicating with an accessory through sub-communication means (see col. 4, lines 56-58; Fig. 1 "ref. 22, 23"), and said accessory capable of communicating with said cellular telephone set through said sub-communication means (see Figs. 3 "ref. 37, 39-40, 202, 204"; 4 "ref. 205"), and can execute a communication function other than a voice communication function by said cellular telephone set through said sub-communication means (see col. 8, lines 49-62), where generating an infrared request signal for television-telephone connection, said cellular telephone set comprising:

cellular telephone transceiver means (e.g., radio communication unit 22, 23) for originating a plurality of calls to a base station (see col. 4, 46-58; Figs. 1-2);

sub-communication means for performing communication with said accessory by means of a call through a channel (see Fig. 3 “ref. 37 and 39-40”); and

control means for, causing said cellular telephone transceiver means to start originating a new call for voice communication with a remote cellular telephone set (see col. 14, lines 30-51), where turning off the television-telephone when moving from one room to another to temporarily suspend the television conversation and allowing or continuing a telephone conversation based on audio signals teaches of deterioration of the channel or signal to not more than a predetermined level. As a note, turning off the television or moving from room to room causes deterioration or degradation of the signal between the television and portable telephone thus utilization of an image display is not necessary at that particular instance.,

said new call being other than a call used by the cellular telephone set to perform sub-communication with the accessory (see col. 14, lines 30-51), and said accessory comprises:

sub-communication means for performing communication with said cellular telephone set (see Fig. 3 “ref. 37, 39-40, 202, 204”; 4 “ref. 205”);

expression means for expressing a content transferred by said sub-communication means (see Figs. 1 “ref. 205 and 305”; 4 “ref. 205”). Tokoro does not specifically disclose having the features said cellular telephone set comprising: channel monitoring means for monitoring channel quality of said sub-communication means; control means for, causing said cellular telephone transceiver means to start originating a new call when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, said

accessory comprises: channel monitoring means for monitoring channel quality of said sub-communication means; and control means for, when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, notifying said cellular telephone set of the corresponding information. However, the examiner maintains that the features said cellular telephone set comprising: channel monitoring means for monitoring channel quality of said sub-communication means; control means for, causing said cellular telephone transceiver means to start originating a new call when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, said accessory comprises: channel monitoring means for monitoring channel quality of said sub-communication means; and control means for, when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, notifying said cellular telephone set of the corresponding information was well known in the art, as taught by Tsai.

In the same field of endeavor, Tsai discloses the features said cellular telephone set comprising: channel monitoring means for monitoring channel quality of said sub-communication means; control means for, causing said cellular telephone transceiver means to start originating a new call when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, said accessory comprises: channel monitoring means for monitoring channel quality of said sub-communication means; and control means for, when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, notifying said cellular telephone set of the corresponding information (see col. 2, lines 54-58; col. 5, lines 10-39; Figs. 2-3 and 5),

where the device switches operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode. For example, the method switches the device from a data transfer mode to a voice mode if the frames counter exceeds a preset frames counter threshold.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tokoro and Tsai to have the features said cellular telephone set comprising: channel monitoring means for monitoring channel quality of said sub-communication means; control means for, causing said cellular telephone transceiver means to start originating a new call when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, said accessory comprises: channel monitoring means for monitoring channel quality of said sub-communication means; and control means for, when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, notifying said cellular telephone set of the corresponding information, in order to detect transmission energy to allow switching between fax/modem, silence, or voice operation mode, as taught by Tsai (see col. 1, lines 54-65).

Regarding **claim 11**, the combination of Tokoro and Tsai discloses every limitation claimed, as applied above (see claim 10), in addition Tokoro further discloses an apparatus according to claim 10, wherein said accessory comprises a videophone unit (see col. 7, lines

4-20; col. 4, lines 56-61; Fig. 1 “ref. 205”), where the system uses a television unit for generating video signals.

Regarding **claim 12**, the combination of Tokoro and Tsai discloses every limitation claimed, as applied above (see claim 10), in addition Tokoro further discloses an apparatus according to claim 10, wherein said accessory comprises a musical unit (see col. 7, lines 4-20; Fig. 1 “ref. 205”), where the system uses a television unit for generating audio signals.

Regarding **claim 13-15**, the combination of Tokoro and Tsai discloses every limitation claimed, as applied above (see claims 10-12), in addition Tokoro further discloses an apparatus according to claims 10-12, wherein said sub-communication means is infrared communication (see col. 4, lines 56-58; col. 5, lines 3-8; Fig. 1).

**Claims 16-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tokoro (US 6,349,324)** in view of **Tsai (US 6,757,301 B1)** as applied to claims 10 above, and further in view of **Tryding (US 5,880,732)**.

Regarding **claims 16-18**, the combination of Tokoro and Tsai discloses every limitation claimed as applied above in claims 10-12. The combination of Tokoro and Tsai does not specifically disclose having the feature wherein said sub-communication means is radio communication. However, the examiner maintains that the feature wherein said sub-communication means is radio communication was well known in the art, as taught by Tryding.

In the same field of endeavor, Tryding discloses the feature wherein said sub-communication means is radio communication (see col. 2, lines 52-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tokoro, Tsai, and Tryding to have the feature wherein said sub-communication means is radio communication, in order provide the usage of an external display monitor for the presentation of mobile telephone display information, as taught by Tryding (see col. 1, lines 39-42).

Regarding **claim 19**, Tokoro discloses a communication method for a cellular telephone apparatus including a cellular telephone set capable of originating a call in addition to a call for voice communication (see col. 4, lines 56-58; Fig. 1 “ref. 22-23”), and

an accessory capable of communicating with the cellular telephone set through a call by using a radio channel for sub-communication (see Figs. 3 “ref. 37, 39-40, 202, 204”; 4 “ref. 205”),

when the cellular telephone set can perform voice communication with a remote cellular telephone set (see col. 14, lines 30-51),

the cellular telephone set is allowed to perform voice communication with the remote cellular telephone set by originating a new call, other than a call used by the cellular telephone set to perform said sub-communication with the accessory (see col. 14, lines 30-51), where turning off the television-telephone when moving from one room to another to temporarily suspend the television conversation and allowing or continuing a telephone conversation based on audio signals teaches of deterioration of the channel or signal to not more than a predetermined level. As a note, turning off the television or moving from room to room causes deterioration or degradation of the signal between the television and portable telephone thus utilization of an image display is not necessary at that particular instance.



Tokoro does not specifically disclose having the feature wherein even if channel quality of a radio channel for the sub-communication has deteriorated to not more than a predetermined level. However, the examiner maintains that the features wherein even if channel quality of a radio channel for the sub-communication has deteriorated to not more than a predetermined level was well known in the art, as taught by Tsai.

In the same field of endeavor, Tsai discloses the feature wherein even if channel quality of a radio channel for the sub-communication has deteriorated to not more than a predetermined level (see col. 2, lines 54-58; col. 5, lines 10-39; Figs. 2-3 and 5), where the device switches operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode. For example, the method switches the device from a data transfer mode to a voice mode if the frames counter exceeds a preset frames counter threshold.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tokoro, Tsai, and Tryding to have the feature wherein even if channel quality of a radio channel for the sub-communication has deteriorated to not more than a predetermined level, in order to detect transmission energy to allow switching between fax/modem, silence, or voice operation mode, as taught by Tsai (see col. 1, lines 54-65).

Regarding **claim 20**, Tokoro discloses a communication method of communicating between cellular telephone apparatuses with each other, each of said apparatuses including a

cellular telephone set capable of originating a call in addition to a call for normal voice communication (see col. 4, lines 56-58; Fig. 1 "ref. 22-23"), and an accessory capable of communicating with the cellular telephone set by making use of a radio channel for sub-communication through a call (see Fig. 3 "ref. 37, 39-40, 202, 204"; 4 "ref. 205"), comprising the steps of:

inputting a telephone number of a remote cellular telephone apparatus by operating a ten-key mounted in an originating cellular telephone apparatus so as to start the sub-communication (see col. 5, lines 36-42; Fig. 2 "ref. 16 and 16A");

transmitting corresponding information through infrared light from the accessory to a cellular telephone set mounted in said originating cellular phone apparatus so as to originate a call (see col. 5, lines 56-63; col. 8, lines 48-53; Fig. "ref. 16A");

starting communication from the cellular telephone set mounted in said originating cellular telephone apparatus to the remote cellular telephone apparatus through base stations (see col. 7, line 63 - col. 8, line 7; Fig. 1 "ref. 201, 301, 231-1, 231-2") and

activating display units to transmit and receive a sensed image signal and the like and display a corresponding images so as to perform videophone communication (see col. 12, line 8 - col. 13, line 7);

checking whether communication using a voice call can be performed between cellular telephone sets respectively mounted in said cellular telephone apparatuses (see col. 7, line 63 - col. 8, line 47), where the portable telephone outputting an electric wave conveying a calling signal to the closet base station, then an electric wave conveying the call signal is transmitted by the base station to another portable telephone for voice communications;

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originating a new call from the cellular telephone set mounted in the originating cellular telephone apparatus to the cellular telephone set mounted in the remote cellular telephone apparatus, the new call being other than a call used for the sub-communication (see col. 7, line 63 - col. 8, line 47);

starting voice communication when the voice call is originated (see col. 7, line 63 - col. 8, line 47); and

terminating the sub-communication (see col. 14, lines 30-51), where turning off the television-telephone when moving from one room to another to temporarily suspend the television conversation and allowing or continuing a telephone conversation based on audio signals teaches of deterioration of the channel or signal to not more than a predetermined level. As a note, turning off the television or moving from room to room causes deterioration or degradation of the signal between the television and portable telephone thus utilization of an image display is not necessary at that particular instance. Tokoro does not specifically disclose having the features monitoring a channel quality of the sub-communication to determine whether the channel quality has deteriorated to a predetermined level or less; if the channel quality is determined to be deteriorated to a predetermined level or less. However, the examiner maintains that the features monitoring a channel quality of the sub-communication to determine whether the channel quality has deteriorated to a predetermined level or less; if the channel quality is determined to be deteriorated to a predetermined level or less was well known in the art, as taught by Tsai.

In the same field of endeavor, Tsai discloses the features monitoring a channel quality of the sub-communication to determine whether the channel quality has deteriorated to a

predetermined level or less; if the channel quality is determined to be deteriorated to a predetermined level or less (see col. 2, lines 54-58; col. 5, lines 10-39; Figs. 2-3 and 5), where the device switches operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice mode. For example, the method switches the device from a data transfer mode to a voice mode if the frames counter exceeds a preset frames counter threshold.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Tokoro, Tsai, and Tryding to have the features monitoring a channel quality of the sub-communication to determine whether the channel quality has deteriorated to a predetermined level or less; if the channel quality is determined to be deteriorated to a predetermined level or less, in order to detect transmission energy to allow switching between fax/modem, silence, or voice operation mode, as taught by Tsai (see col. 1, lines 54-65).

***Response to Arguments***

3. Applicant's arguments filed 21 December 2006 have been fully considered but they are not persuasive.

The Examiner respectfully disagrees with applicant's arguments as the applied reference(s) provide more than adequate support and to further clarify (see the above claims for relevant citations and the comments in this section).

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding applicant's argument of claims 10-15 on pg. 8, 1<sup>st</sup> paragraph, "...fails to specifically disclose both a cellular telephone apparatus and an accessory comprising a channel monitoring means for monitoring channel quality of the sub-communications means and a control means for notifying the cellular telephone set of a deterioration in channel quality of the sub-communications means to a level no more than a predetermined level, causing the cellular apparatus to start originating a call...", the Examiner respectfully disagrees. As a note, the instant application recites "...calls (channels)..." on pg. 8, line 8. The combination of Tokoro and Tsai more than adequately meets the claim language.

In particular, Tokoro discloses the feature control means for, causing said cellular telephone transceiver means to start originating a new call for voice communication with a remote cellular telephone set (see col. 14, lines 30-51), where turning off the television-telephone conversation mode when moving from one room to another to temporarily suspend

the telephone-television conversation and establishing, allowing, or continuing a telephone conversation mode based on *audio signals* teaches of deterioration of the channel or signal to not more than a predetermined level. As a note, turning off the television or moving from room to room causes deterioration or degradation of the signal between the television and portable telephone thus utilization of an image display is not necessary at that particular instance. The television-telephone conversation utilizes infrared-ray which is a short-range signal that is typically line-of-sight or straight-line signal that would degrade from an obstruction such as walls of a room as evidenced by the fact that one of ordinary skill in the art would clearly recognize.

Tsai discloses the features said cellular telephone set comprising: channel monitoring means for monitoring channel quality of said sub-communication means; control means for, causing said cellular telephone transceiver means to start originating a new call when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, said accessory comprises: channel monitoring means for monitoring channel quality of said sub-communication means; and control means for, when the channel quality of said sub-communication means has deteriorated to not more than a predetermined level, notifying said cellular telephone set of the corresponding information (see col. 2, lines 54-58; col. 5, lines 10-39; Figs. 2-3 and 5), where the device switches operating modes according to energy statistics when monitoring exchanged data, if the device is operated in data exchange mode (PCM mode, used with fax/modem data) and silence is detected or speech is encoded according to energy statistics the operation is switched to operate in voice

mode. For example, the method switches the device from a data transfer mode to a voice mode if the frames counter exceeds a preset frames counter threshold.

5. In response to applicant's argument that Tsai is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tsai is concerned with similar features in the area of communications as the subject matter claimed by applicant.

Regarding applicant's arguments of the claims 16-20, the claims are addressed according to the same reasons as set forth in the items above and as applied above in each claim rejection.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willie J. Daniel, Jr. whose telephone number is (571) 272-7907. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/WJD,JR/

WJD,JR  
13 March 2007



CHARLES N. APPIAH  
SUPERVISORY PATENT EXAMINER